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EXAMINER

HUNTSINGER, PETER K

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/065,527
Filing Date: October 25, 2002
Appellant(s): DENNISON ET AL.

MAILED

AUG 29 2007

Technology Center 2600

Charles W. Peterson, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/27/06 appealing from the Office action mailed 2/9/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

3. Claims 6-8 and 14-16 are finally rejected under 35 U.S.C. §103(a) over Livingston in combination with published U.S. Patent Application No. 2002/0184305 to Simpson et al.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

- a. Claims 4 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,614,454	Livingston	9-2003
6,880,124	Moore	4-2005
2002/0184305	Simpson et al.	12-2002
6,268,924	Koppolu et al.	7-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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2. Claims 1, 3-5, 9, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Livingston U.S. Patent 6,614,454.

Referring to claims 1 and 9, Livingston discloses a method comprising: displaying a plurality of original document visual objects of an original document (print preview image 68 of Fig. 3A, col. 5, lines 38-39); inserting into the original document a plurality of visual cue objects corresponding to print job ticketing parameters, thereby creating an amended document (staples 69 of Fig. 3A, col. 5, lines 38-39), and displaying the plurality of visual cue objects (S5 of Fig. 2, col. 4, lines 2-6); and removing from the amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects (staples 69 of Fig. 3A, col. 5, lines 38-39) and performing the specific operations ("Staple this Job Using" of Fig. 3A, col. 5, lines 17-20). When the user deselects "Staple this Job Using", the staples displayed on print preview image 68 will be removed (S9 of Fig. 4, col. 6, lines 1-20, settings are applied and print preview is updated).

Referring to claims 3 and 11, Livingston discloses removing from the amended document, for printing to be performed on the amended document, at least one of the plurality of visual cue objects (staples 69 of Fig. 3A, col. 5, lines 38-39) and performing the printing ("Print" of Fig. 3A, col. 5, lines 17-20). When the user prints the document, the staples displayed on print preview image 68 showing where the staples will appear are not be printed and must be removed prior to printing.

Referring to claims 4 and 12, Livingston discloses the method of claim 1 wherein said step of inserting further includes inserting an unseen marker with each of the

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plurality of visual cue objects and wherein said step of removing the at least one of the plurality of visual cue objects further includes locating the unseen marker. It is inherent that the program of Livingston needs to track of whether the option for staples has been selected or not. A register or variable present in the program code indicates the selection of the user and is and unseen marker. The selection or deselection of the "Staple this Job Using" button would require locating the register or variable to record the result.

Referring to claims 5 and 13, Livingston discloses the method of claim 1 wherein said step of inserting further includes maintaining a list of each of the plurality of visual cue objects inserted (col. 5, lines 20-27) and wherein said step of removing the at least one of the plurality of visual cue objects further includes referencing the list and identifying the at least one of the plurality of visual cue objects to be removed. As is shown in Fig. 3A of Livingston, the option of stapling is provided sequentially is a list format. The user is able to visible view the list and determine which staples that are desired to be removed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston U.S. Patent 6,614,454 as applied to claim 1 above, and further in view of Moore U.S. Patent 6,880,124.

Referring to claims 2 and 10, Livingston discloses removing from the amended document, for printing to be performed on the amended document, at least one of the plurality of visual cue objects (staples 69 of Fig. 3A, col. 5, lines 38-39) and performing the printing ("Print" of Fig. 3A, col. 5, lines 17-20). When the user prints the document, the staples displayed on print preview image 68 showing where the staples will appear are not be printed and must be removed prior to printing. Livingston does not disclose expressly the specific operation of saving. Moore discloses automatically saving a document when printing (col. 7, lines 12-18). Livingston and Moore are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious for a person of ordinary skill in the art to automatically save a document when printing. The motivation for doing so would have been to create a backup file for printed documents in case the user's file is not printed correctly or further copies are desired. Therefore, it would have been obvious to combine Moore with Livingston to obtain the invention as specified in claims 2 and 10.

5. Claims 6-8 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston U.S. Patent 6,614,454 as applied to claim 1 above, and further in view of Simpson et al. Publication US 2002/0184305.

Referring to claims 6 and 14, Livingston discloses the steps of inserting and removing but does not disclose expressly the steps being performed by a plug-in to a document editor. Simpson et al. disclose plug-in to a document editor providing a plug-in interface (page 1, paragraph 3). Livingston and Simpson et al. are combinable because they are from the same field of print previewing programs. At the time of the invention, it would have been obvious for a person of ordinary skill in the art to apply the print preview program of Livingston as a plug-in to a document editor. The motivation for doing so would have been to increase the flexibility of a program by allowing its incorporation into other programs. Therefore, it would have been obvious to combine Simpson et al. with Livingston to obtain the invention as specified in claims 6 and 14.

Referring to claims 7 and 15, Livingston discloses applying certain of the print job ticketing parameters to all pages of the document ("Apply changes to: All Pages" of Fig. 3B).

Referring to claims 8 and 16, Livingston discloses applying certain of the print job ticketing parameters to selected pages of the document ("Apply changes to: All Pages" of Fig. 3B). The changes are shown to apply to selecting all pages.

6. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston U.S. Patent 6,614,454 as applied to claims 1 and 9 above, and further in view of Koppolu et al. U.S. Patent 6,268,924.

Referring to claims 17 and 19, Livingston discloses displaying the plurality of visual cue objects, but does not disclose expressly the print preview being a thumbnail.

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Koppolu et al. disclose a print preview being a thumbnail (col. 6, lines 27-37).

Livingston and Koppolu et al. are combinable because they are from the same field of print previewing documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for doing so would have been to utilize a space saving image format. Further, a thumbnail file is standard, and well known in the art. Therefore, it would have been obvious to combine Koppolu et al. with Livingston to obtain the invention as specified in claims 17 and 19.

7. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston U.S. Patent 6,614,454 and Simpson et al. Publication US 2002/0184305 as applied to claims 6 and 19 above, and further in view of Koppolu et al. U.S. Patent 6,268,924.

Referring to claim 18, Livingston discloses displaying the plurality of visual cue objects, but does not disclose expressly the print preview being a thumbnail. Koppolu et al. disclose a print preview being a thumbnail (col. 6, lines 27-37). Livingston and Koppolu et al. are combinable because they are from the same field of print previewing documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for doing so would have been to utilize a space saving image format. Further, a thumbnail file is standard, and well known in the art. Simpson et al. disclose plug-in to a document editor providing a plug-in interface (page 1, paragraph 3).

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Livingston discloses monitoring the print preview for the current page selection (col. 5, lines 39-44). Therefore, it would have been obvious to combine Koppolu et al. with Livingston and Simpson et al. to obtain the invention as specified in claim 18.

Referring to claim 20 Livingston discloses displaying the plurality of visual cue objects, but does not disclose expressly the print preview being a thumbnail. Koppolu et al. disclose a print preview being a thumbnail (col. 6, lines 27-37). Livingston and Koppolu et al. are combinable because they are from the same field of print previewing documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for doing so would have been to utilize a space saving image format. Further, a thumbnail file is standard, and well known in the art. Simpson et al. disclose plug-in to a document editor providing a plug-in interface (page 1, paragraph 3). Livingston and Simpson et al. are combinable because they are from the same field of print previewing programs. At the time of the invention, it would have been obvious for a person of ordinary skill in the art to apply the print preview program of Livingston as a plug-in to a document editor. The motivation for doing so would have been to increase the flexibility of a program by allowing its incorporation into other programs. Livingston discloses monitoring the print preview for the current page selection (col. 5, lines 39-44). Therefore, it would have been obvious to combine Koppolu et al. and Simpson et al. with Livingston to obtain the invention as specified in claim 20.

(10) Response to Argument

Appellant argues whether claims 1, 3-5, 9, and 11-13 stand rejected under 35 U.S.C. 102(e) as being anticipated by Livingston U.S. Patent 6,614,454.

On pages 7-10 of the remarks, Appellant alleged that Livingston fails to teach anything that could be considered an amended document.

In response to the argument, the Examiner noted that the specification lacks a clear definition of the term document. According to the definition within the art, a document is a writing that contains information (found on www.dictionary.com). The print preview image 68 of Livingston (Fig. 3A, col. 5, lines 38-39) clearly demonstrates a writing (has text) that contains information (corresponds to a print job, col. 5, lines 43-44).

Further, Appellant's argument that the definition of a document is "d. Computer Science. A piece of work created with an application, as by a word processor. e. Computer Science. A computer file that is not an executable file and contains data for use by applications" is unreasonable narrow. A printed document is clearly a recognized term to someone of ordinary skill within the art but this would not fall under the limited definition used by the Appellant. Furthermore, the Appellant's specification uses the term "printed output document" (page 4, paragraph 14). Therefore, one of ordinary skill in the art would recognize the broader definition of document as meaning writing that contains information.

On pages 9 and 10 of the remarks, Appellant alleged that Livingston '454 does not teach inserting visual cues into an original document to create an amended document

and removing the visual cues from the amended document consistent with the specification.

Livingston '454 discloses inserting into the original document a plurality of visual cue objects corresponding to print job ticketing parameters, thereby creating an amended document (staples 69 of Fig. 3A, col. 5, lines 38-39), and removing from the amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects (staples 69 of Fig. 3A, col. 5, lines 38-39) (when the user deselects "Staple this Job Using", the staples displayed on print preview image 68 will be removed, S9 of Fig. 4, col. 6, lines 1-20, settings are applied and print preview is updated).

On page 11 of the remarks, Appellant alleged that Moore '124 is inconsistent with the teaching of Livingston '454.

Livingston '454 discloses an amended document (print preview image 68 of Fig. 3A, col. 5, lines 38-39). Moore '124 teaches automatically saving a document when printing (col. 7, lines 12-18). Whether or not the amended document of Livingston '454 is the identical document of Moore '124, it is apparent that images can clearly be saved. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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On page 11 of the remarks, Appellant alleged that Simpson '305 fails to teach the above identified elements missing from Livingston '454.

The Examiner has addressed the arguments as discussed above

On page 12 of the remarks, Appellant alleged Koppolu '924 fails to teach the above noted missing elements.

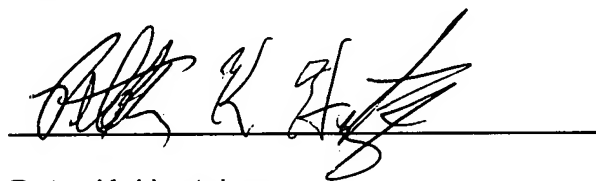
The Examiner has addressed the arguments as discussed above

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter K. Huntsinger', is written over a horizontal line.

Peter K. Huntsinger

Examiner (2625)

Conferees:

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